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EXAMINER

LAMM, MARINA

ART UNIT PAPER NUMBER

1616

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 040904

Application Number: 10/051,994
Filing Date: January 22, 2002
Appellant(s): LOPEZ, ARMANDO R.

MAILED

APR 20 2004
GROUP

Evelyn M. Sommer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/10/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-4, 6-13, 17 and 18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and *reasons in support thereof*. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

US 5,725,875	NOLL et al.	3-1998
US 5,942,238	MCATEE et al.	8-1999
EP 0 626 167 A2	GUCK (translation)	11-1994
US 3,961,044	KELLY et al.	6-1976

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-4, 6-12, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noll et al. in view of Guck as evidenced by McAtee et al.

Noll et al. teach protective skin compositions in the form of suspensions, emulsions, lotions, ointments and aerosol gels that form a film on the skin effective as a topical barrier, said film being easily removable by washing. See col. 2, lines 25-45; col. 3, lines 18-24, 43-46; col. 14, line 40; col. 17, lines 52-67. The compositions contain glycerin and may contain sunscreens and oleaginous substances such as cetyl alcohol, glyceryl hydroxystearate, and silicones. See Abstract; col. 7, lines 51-58; col. 9, lines 16-21. Noll et al. do not teach a lathering surfactant present in an amount of about 1 to about 10% by weight as claimed in the instant claims. However, Guck teaches compositions for skin protection comprising 1-3% of foaming surfactants such as sodium lauryl ether sulfates. See pp. 3-4 of the translation. Sodium lauryl ether sulfates of Guck are used for reducing the surface tension. See p. 3 of the translation. McAtee et al. teach that lowering of surface tension leads to better softening and breaking up of the lipid and silicone base of the skin products and thus, to improved removing of the lipid- and silicone-containing skin products from the skin. See col. 1, lines 59-64.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Noll et al. such that to employ 1-3 % of sodium lauryl ether sulfates of Guck. One having ordinary skill in the art would have been motivated to do this to obtain readily removable skin protecting compositions as suggested by McAtee et al.

2. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noll et al. in view of Guck as evidenced by McAtee et al. as applied to claims 1 and 3 above, and further in view of Kelly et al.

Noll et al. in view of Guck as evidenced by McAtee et al. applied as above. While teaching lipid substances such as cetyl alcohol, glyceryl hydroxystearate and silicones, the reference does not explicitly teach lipids of Claim 13. However, such lipids are conventionally used in skin care compositions for the same purpose as lipids of Noll et al., i.e., as skin emollients and/or protectants. Thus, Kelly et al. teach skin protective compositions in the form of creams and lotions containing beeswax, mineral oil, cetyl alcohol, lanolin and other cosmetic substances. See col. 7, lines 1-26; col. 10, Examples 2 and 3. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use lipids of Kelly et al. for compositions of Noll et al. for their art-recognized purpose.

(11) Response to Argument

In response to the Applicant's argument that "the Noll et al compositions are not taught or suggested for the same or a similar purpose as herein stated by the applicant" (see p. 4 of the Brief), it is noted that the recitation of purpose/intended use in the preamble, i.e. "can

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prevent contact and passage to the skin of toxic chemicals and irritants found in the cosmetic industry”, is not limiting and is not given any patentable weight because the body of the claim fully sets forth all the limitations of the claimed composition. See MPEP 2111.02 and cases cited therein. Further, it is noted that both the claimed composition and the composition of Noll et al., *are* used for the same purpose, i.e. protecting the skin from various skin-harmful agents.

Further, the Applicant argues that “there is no recognition in Guck that the surfactant serves other than in forming the foam.” See p. 6 of the Brief. In response, Guck explicitly teaches using tensides such as sodium lauryl ether sulfates (Applicant’s exemplified foaming surfactants – see p. 13 of the specification) “for reducing the surface tension”, which will result in improved removing of the lipid- and silicone-containing skin products from the skin as taught by McAtee et al. See Guck at p.3 of the translation and McAtee et al. at col. 1, lines 59-64. Therefore, one having ordinary skill in the art at the time the invention was made would have been motivated to modify the compositions of Noll et al. such that to employ sodium lauryl ether sulfates of Guck to obtain readily removable skin protecting compositions as suggested by McAtee et al.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday-Friday 9am-530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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